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EXAMINER

KESSLER, A

ART UNIT

PAPER NUMBER

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3

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 3711

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-28, drawn to computer controlled talking toy, classified in class 446, subclass 298.
 - II. Claims 29-34, drawn to a data storage media instructions method, classified in class 369, subclass 63.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions computer controlled talking toy and storage media instructions are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). The subcombination has separate utility such as any type of voice system used with a computer.
3. During a telephone conversation with Marc A. Hubbard on March 26, 1998 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 4, 8, 10, 13, 17, 21, 24-25, 27-28 and those dependent therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is confusing in reciting "means for transmitting to the loudspeaker" in not stating what is transmitted to the loudspeaker. Examiner believes applicant means to reciting transmitting sound to the loudspeaker. Claims 3, 10, 17 and 21 are confusing in reciting ". . . in the text from the text file." It is unclear how "from the text file" further limits the claim. Claim 25 is confusing in reciting "the other direction" in that it is unclear whether applicant meant "the opposite direction."

7. Claims 1-28 are replete with improper antecedent basis. For example, claim 1 recites the limitations "the digital data signals" in the fourth to the last line of the claim and "the sound card" in the in the last line of the claim. There is insufficient antecedent basis for these limitations in the claim. See also claims 2-4, 8, 10, 13, 24, and 27-28 for other identified improper antecedent basis. This list is exemplary and not exhaustive.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 1-2, 9, and 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Tong. Tong, an interactive computer controlled doll teaches all the limitations of the above claims. Tong provides a digital data signal in the program data to the actuator for moving the articulating members. Tong synchronizes movement of the mouth in accordance with the sound to enhance the appearance that they are being spoken by the bear 3:3-16. Tong also provides a means for recording and recognizing spoken words 4:58-67.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tong. Tong does not specifically teach creating a second dimension to the control code array for moving the

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second articulating member. However, it would have been obvious to one skilled in the art at the time the invention was made to provide a second dimension to synchronize the second articulating member with the first and thus, the sound. Tong already provides for a second articulating member. Increasing the array dimension with the same binary data to provide movement data to that second member without constructing an independent array would be a simple and efficient method of moving the second member.

12. Claims 3-8, 10, 14, 17-25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tong in view of Gasper et al.

Tong, an interactive computer controlled doll, teaches essentially all the limitations in the above claims except generating a text file or a sound dictionary file, identifying vowels and consonants for opening and closing the mouth, and receiving third and fourth digital data representing movement of an arm in a first and second direction.

Gasper teaches an authoring and use system for sound synchronized animation for use in a game 2:51-67. Gasper builds and saves its own dictionary file after determining the proper lip synchronization of a word 4:13-22. Gasper also teaches using three types of coarts for sound articulation: silence, vowels, and consonants, which can use for non-movement, opened, and closed mouth 28:25-47. Thus, two coarts could also be used to just represent opened and closed. The data array created for mouth movement can be easily replicated and used to articulate a second member. Gasper does not teach employing this system in a physical doll.

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However, it would have been obvious to one skilled in the art at the time the invention was made to modify the Tong system to include the synchronized animation system in Gasper. Tong teaches using program data for sound and movement data, but does not teach the specific method used to synchronize mouth movement. Tong also teaches using a sound card, but does not teach the particulars of the speech data. Gasper's synchronization system provides these details and is realistic and therefore, would capture a child's attention longer.

13. Claims 15-16 and claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tong and Gasper as applied above to claims 14 and 25 respectively, and further in view of Noll.

Noll teaches an electronically animated talking doll employing an electromagnet (solenoid) to move the mouth and a spring and tension link (string) to pivot the mouth in a first and second direction 3:59-4:11. Noll employs a manual switch 5:5-20 to operate the solenoid, not a digital data signal.

However, it would have been obvious to one skilled in the art at the time the invention was made to modify the Tong-Gasper combination to employ a solenoid with a spring and string to actuate the doll's mouth as taught in Noll. A solenoid with a spring and string is a type of drive motor, as taught in Tong, is but one type of actuator capable of opening and closing a doll's mouth and is simply a design choice which absent criticality is left to the designer's discretion.

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14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baer is cited as being closely related to the instant invention.

15. Any inquiry concerning this communication should be directed to Examiner Kessler at telephone number (703) 308-4987.



Alison Kessler 4.26.99



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